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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,553	06/28/2001	Mark Lewis	P 279171 P11166	5111

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EXAMINER

PHILIPPE, GIMS S

ART UNIT	PAPER NUMBER
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2613

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,553

Applicant(s)

LEWIS, MARK

Examiner

Gims S. Philippe

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on December 15, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. Applicant's amendment received on December 15, 2004 has been fully considered and entered, but the arguments are not deemed to be persuasive.

Note: The examiner acknowledges the changes made to claims 1, 9, and 17.

However, the amendment requires no new prior art to maintain the rejection. The rejection is repeated below for the sake of completeness.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent application no. 09/912,427 (Publication no. US2003/0078968 A1) to Needham et al. for the same reasons as previously set forth in the last Office action mailed on November 27, 2004.

Response to Arguments

Regarding the double patenting rejection, the applicant argues that *"the mere fact that both inventions are directed to the goal of sharing images is irrelevant. What is relevant is the fact that the inventions are directed to different concepts that are patentably distinct."* While the examiner understand the applicant's argument, the examiner respectfully disagrees. In determining whether the claims should be rejected under obviousness-type double patenting, the examiner compared all the claims of both applications. The fact remains that both claimed inventions are directed to *"image sharing based on a sharing rule"*. In additions, the difference between the claims is so obvious that if one of the application is allowed, the other application should also be allowed. In other words, an obvious difference cannot be used to obviate a double patenting rejection and eliminate the need for a terminal disclaimer. In the instant case, the examiner believes that a terminal disclaimer is necessary to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

The double patenting rejection is, therefore, maintained and it is considered final.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-2, 4-7, 9-11, 13-15, 17-18, 21-23, 25, 28-37 and are rejected under 35 U.S.C. 102(e) as being anticipated by Wiryaman (US Patent no. 6,157,401) .

Regarding claims 1, 17, 25 and 31, Wiryaman discloses the same Wiryaman discloses a method for location-based image sharing (See Abstract), comprising defining a sharing rule that specifies with which one or more recipients images are shared based on location-identifying information associated with the one or more recipients images (See col. 3, lines 11-32, and col. 6, lines 30-43), and applying location-identifying information associated with an image to the sharing rule to determine the one or more recipients with which the image should be shared (See col. 5, lines 1-9, and lines 46-54). The applicant should note that the “*various endpoints*” are the “*one or more recipients*”. The applicant should note that the configuration of the gate keeper is considered as the claimed “sharing rule”. In other words, the gate keeper will either grant or deny access to the user for videoconferencing based on the “*sharing rule*”.

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As per claims 2, 4, 6, 10, 14, 18, 22, 29, 32, and 35-36 most of the limitations of these claims have been noted in the above rejection of claims. In addition, Wiryaman's gatekeeper automatically send the digital image once the requested admission is granted (See col. 5, lines 1-25). Note that the gatekeeper will automatically send the image to any location including a Web site as long as the address is registered.

As per claims 5, 7, 13, 15, 21, 23, 28, 30, and 34, Wiryaman further provides location-identifying information comprising latitude and longitude coordinates, proximity identifying information, and a set of location-identifying information (See col. 6, lines 4-11).

As per claim 33, the registry end point in Wiryaman is considered as the claimed database further provides location (See col. 3, lines 42-63).

As per claims 9 and 37, most of the limitations of these claims have been noted in the above rejection of claim 1. In addition, in order for Wiryaman's gatekeeper 18 to properly manage the communication a buddy list is a must as explained in col. 3, lines 21-24, lines 64-67, and col. 4, lines 1-7.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3, 8, 11-12, 16, 19, 20, 24, 26, and 27 are rejected under 35 U.S.C.

103(a) as being unpatentable over Wiryaman (US Patent no. 6,157,401) in view of Maali et al. (US Patent no. 6,567,775).

Regarding claims 3, 8, 12, 16, 19, 20, 24, 26, and 27, most of the limitations of these claims have been noted in the above rejection of claims 1, 11.

It is noted that Wiryaman is silent about defining the share rule based on face identifying information, a body list, and face recognition technique list stored in a face information database.

However, Maali discloses an image sharing apparatus and method including defining a share rule based on face identifying information, a body list, and face recognition technique stored in a face information database (See Maali fig. 4, items 415 and 420, figs. 8-9, and col. 2, lines 38-45, col. 4, lines 5-8, col. 5, lines 56-63).

Therefore, it is considered obvious that one skilled in the art at the time of the invention would recognize the advantage of modifying Wiryaman's image sharing system by incorporating Maali's share rule based on face identifying information, a body list, and face recognition technique stored in a face information database. The motivation for performing such a modification in Wiryaman is to perform proper

speaker/user or client recognition in order to permit searching and retrieval of digital data as taught by Maali (See Maali col. 2, lines 1-26, and lines 38-45).

Response to Arguments

The applicant argues that the independent claims call for “defining a sharing rule that specifies which one or more recipients images are shared based on location identifying information associated with the one or more recipients”. In response to the preceding arguments, the examiner reminds the applicant that the sharing rule is understood as being the gatekeeper denying or granting access to a user requesting a conference. In addition, when the gatekeeper recognizes the message as a conference request from a specific endpoint such request is associated with the recipients (or endpoint) (See Wiryaman col. 6, lines 30-49).

The applicant further argues that there is no mention of “applying location-identifying information to determine the one or more recipients”. The examiner reminds the applicant that while not the same exact words were used by Wiryaman to show the step of “applying location-identifying information to determine the one or more recipients”, however, such step is present in col. 5, lines 26-54 where a destinationInfo field provides a “compound address” where a multipoint control unit set up a video conference.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sheridan (US Patent no. 5760917) teaches image distribution method and system. The applicant should note that Sheridan meets most of the limitations of the independent claims. For example in col. 6, lines 13-35, an image sharing rule is disclosed. In addition, in col. 5, lines 7-64, a more detailed disclosure is given on the image sharing rule.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gims S. Philippe whose telephone number is (571) 272-7336. The examiner can normally be reached on M-F (9:30-7:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris S. Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gims S Philippe
Primary Examiner
Art Unit 2613

GSP

May 26, 2005